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ABSTRACT

The Constitution empowers Congress to protect the rights of authors. There is disagreement, however, over whether Congress may grant authors a limited monopoly on their works or may regulate authorship by permitting reasonable public access to creative works. The traditional view of expansive pre-publication rights for authors is supported by those with interests in: (1) protecting a work before it is published; (2) assuring that the work is ready for publication; and (3) guarding authors' control over the timing of publication. On the other side are public interests in: (1) commenting on matters of public concern; (2) being exposed to information, even absent publication; and (3) being exposed to information in raw, unedited form. The Copyright Act of 1976 codified the traditional distinction between expression, which is legally protected, and ideas, which are not. Under the Act, pre-publication rights of authors remain unsettled. Actions for misappropriation of unpublished works generally fail. Some contract-related suits may be preempted under the Act. Authors' suits for invasion of privacy are not recognized in all states, and may be preempted under the Act. The United States Supreme Court has held that an author's right of first publication outweighed the right of "fair use" by another publisher. The controversy goes to the heart of how best to foster robust debate in a democratic society. Students who contemplate becoming professional writers should be informed of this debate over the rights of authors. (Seventy-six notes are included; 39 references are attached.) (SG)

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DOES FREEDOM OR DO MONOPOLIES BETTER FOSTER EXPRESSION: THE PROBLEM OF PRE-PUBLICATION RIGHTS OF AUTHORS

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I. Introduction

Long before a best selling novelist is lionized on book promotion tours, long before the critics rave about the opening night of a playwright's smart new play, and long before historians see a public figure anew through the critical insights of a master biographer, an author worked to create or adapt ideas and then express them. Sometimes the journey from idea to expression is easy. More often the author must go through angst as each bit of expression is painfully pulled out of its underlying idea.

During this period, authors are often vulnerable. They must negotiate with one or more publishers, consult with colleagues, and arrange for marketing and publicity of their work. It is easy for others to steal ideas or even quotations from the work and release them to an inquisitive public. The thunder of the work might be stolen and the value of the work might plummet.

What are the rights of an author during this pre- publication process? Should the First Amendment protect those who expose part of an author's new work, especially if the author is holding something which would contribute to meaningful public debate? Does the law create a climate for intellectual industry while allowing reasonable access to intellectual products? These questions are central to the clash between the First Amendment, copyright, and the state statutory, common law, and equitable rights which protect similar though not identical interests.

This article will analyze the pre-publication rights of authors under the Copyright Act of 1976 1/ and surviving state common law and equity protections. It includes a review of the pre-publication approaches used during the authority of the Copyright Act

of 1909 and the present act; 2/ an overview of surviving common law, equitable and state statutory rights still available to authors before publication; and an analysis of the federal statutory and constitutional rights of authors after the United States Supreme Court decision in Harper and Row v. Nation Enterprises. 3/

II. The Rationale for Expansive vs. Limited Author Pre-Publication Rights

The Constitution provides the undergirding rationale for copyright. It states that "Congress shall have the power . . . to promote the Progress of Science and Useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." 4/ This provision can be seen in two different but not necessarily exclusive ways. One view is that this provision provides Congress with the authority to create for authors a limited monopoly for their works and that this monopoly will best foster productive work from authors. A second view is that the provision empowers Congress with the authority to regulate authorship by balancing the encouragement of authors with the need to allow the public reasonable access to the ideas which are often intertwined with expression, even if this means that some expression loses protection. 6/

The traditional state statutory, common law and equitable actions are, on the other hand, squarely aimed at protecting authors and their property rights. Actions such as misappropriation, conversion, invasion of privacy, and implied in fact contracts all protect authors from interference with their public or private affairs. These actions generally encourage the dissemination of ideas only so much as they prevent others from

"reaping what is not sown" and thus protect the expenditure of labor, skill, and money which authors and their associates put into their works. 7/ There may be a concern for the availability of intellectual works among the public, but these concerns are usually addressed through limitations on the causes of action.

Therefore, copyright, with a few limited exceptions, protects the expression embodied in a work while the traditional state statutory, common law, and equitable remedies protect the process of creating and honing the work. 8/

The Rationale for Expansive Author Rights

Authors have three main interests in prepublication rights. How these interests are protected by federal copyright and state statutory, common law, and equitable actions will be discussed later in this article.

Firstly, authors have an interest in protecting the labor which they invest in a work before it is published. Authors put two types of labor in their works. The first comes from the special knowledge and experience which they have acquired in order to do the works in the first place. An historian usually has years of schooling and experience which help her or him dig up facts and then analyze them in a compelling manner. The fiction writer or artist might bring education or years of perfecting an idea or technique to the work. The second type of labor comes from work on the work itself. An historian may spend months, if not years, digging up facts and then painstakingly analyzing them. A fiction writer or artist may take a work through many drafts or complete revisions before it is finally ready. Authors have an interest in protecting the investment they have made.

Secondly, an author, and perhaps society, has an interest in making sure that the work is polished and ready for publication. An historian may check and recheck a work for inaccuracies many times before it is in a publishable form. A fiction author or artist may do many revisions and may make many changes before the work is ready for publication. Authors have an interest that their works are not published before they are in a polished form.

Thirdly, like comedians, authors have an interest in timing the publication of their work. For example, a history of presidential debates might create more interest and attract more readers if it is released during a presidential campaign. A particular type of film might attract more viewers if it is released in the summer. On the other hand, it is often important to the authors that they be able to promote their works immediately after publication. For example, an author might need to wait until she or he has left a government post to publish a book so that a cross country promotional tour can be made.

At first blush, it would appear that the simplest remedy for authors would be to just keep their work secret before publication. However, many authors are not in a position to do that. Authors must often share their ideas with many people in order to get financial backing, to secure a publishing contract with an advance, or even to check to see if there is a market for their work before proceeding to complete a finished product. As we shall see, this often leaves authors in a vulnerable position.

The Rationale for Limited Author Rights

On the other hand, those who seek to rely on First Amendment protections to expose the pre-publication work of authors have three main interests. Even though they

are usually motivated by money, there are legitimate interests in free expression beyond mere money.

Firstly, they, and perhaps the public, have an interest in commenting upon matters of public concern as soon as they know about them. They do not want to wait for the long process of publication before the information is exposed to the public.

Secondly, they want to expose the information even if publication never happens. Authors do not always get their works published and sometimes choose not to publish them at all. They, and the public, have an interest that this information sees the light of day.

Thirdly, they have an interest in exposing the information in its raw form. For example, if they learn of material in early versions of a book which deserves to be heard but was edited out of the final version, they want to expose all of the information. In books, government reports, telecasts and so forth there is often a motive to white-wash aspects which puts the authors or their subjects in a bad light. They have an interest in getting this information out in the open.

III. Changes in Pre-publication Rights Embodied in the Copyright Act of 1976

Copyright Prior to the 1976 Act

Copyright before 1978 was covered by an explicit dual system of federal and state copyright protections. The system was laid out in the Copyright Act of 1909 and its 1947 amendments. 9/ Under the system, publication was the all important dividing line between state and federal protections. Once the work was published, federal

copyright protected authors. However, before publication authors were protected by state statutes, common law, or equitable remedies. 10/

The distinction between a published work and an unpublished work was extremely important -- an author could lose rights if she or he did not carefully follow the procedures for securing copyright laid out in the act. Although the difference between unpublished and published works might at first seem simple, this bright line lost much of its illumination. Publication, traditionally envisaged as printed copies, became an increasingly burdensome standard as the "20th - century communication revolution . . . [made] the concept of publication . . . increasingly artificial and obscure." 11/

The House Committee on the Judiciary, in drafting the new act, was troubled by the difficulty that the courts were having in applying the publication standard. The committee reported:

> To cope with the legal consequences of an established concept that has lost much of its meaning and justification, the courts have given "publication" a number of diverse interpretations, some of them radically different. Not unexpectedly, the results in individual cases have become unpredictable and often unfair. 12/

Under the Copyright Act of 1909, if the author had an unpublished work, as determined by the courts, then she or he could seek relief in a plethora of state statutory, common law, or equitable actions. In addition to common law copyright, actions based on misappropriation, breaches of contract, breaches of trust, trespass, conversion, invasion of privacy, defamation, deceptive trade practices and several other theories could be found scattered in reports throughout the country. 13/

For authors who had not yet reproduced their works for sale, or otherwise published them, the Copyright Act of 1909 offered some serious limitations but also some advantages. 14/ The major limitation was that federal copyright protection, with its relatively simple structure and multistate capabilities, was not available prior to publication. The advantages, if any, came from the plethora of state statutory, common law, and equitable actions available which might address the author's problem better than federal copyright.

Copyright After the 1976 Act

The Copyright Act of 1976 dramatically changed the landscape of pre-publication rights for authors and the concept of copyright in general. 15/ The act brought a sweeping new federal presence into the pre-publication world previously dominated by state statutes, common law, and equity.

The breadth of the sweeping change is seen in the very definition of a copyrighted work. Under the new act, the author is entitled to copyright protection as soon as the work is fixed in a tangible medium of expression. 16/
Thus, for most purposes, the awkward distinction between pre- publication and publication is eliminated as soon as the work is fixed in a tangible medium of expression.

Of course, as discused earlier, a common problem with the pre-publication stage of authorship is that the ideas are still being developed and only later will be carefully reduced to expression. Often, at this stage, the ideas are not fixed in a tangible medium of expression and, if they are fixed, are often fixed in little more than rough, crude

drafts or notes which carry little originality in and of themselves. This can be problematic because the Copyright Act of 1976 codifies the traditional copyright distinction between expression, which is protected, and the ideas, procedures, processes, systems, methods of operations, concepts, principles, or discoveries which are not protected. 17/

With this expanded new federal role, Congress limited the role of the states in copyright yet preserved some actions based on problems not covered by federal copyright protection. Section 301 of the Copyright Act of 1976 preempts many of the state statutory, common law, and equitable rights previously available. 18/

However, in 301 (b) of the act, the drafters were careful to exclude from preemption three areas which can still be addressed by state statutes, common law, or equity. The three exceptions are subjects which are not within the subject matter of federal copyright; causes of actions based on undertakings commenced before January 1, 1978; and legal or equitable rights that are not equivalent to any of the exclusive rights within the scope of the copyright act. 19/ As we shall later see, these exceptions still leave some state statutory, common law, and equity protections open to authors during the pre-publication stage.

It should be noted that the drafters did not feel that a work must achieve federal statutory copyright in order to fall within the subject matter of federal copyright, thereby losing state statutory, common law, and equity protection. The House Committee on the Judiciary, in drafting the statute, reported that: "As long as a work falls within one of the general subject matter categories of sections 102 and 103 . . . the bill prevents the

States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify . . . ." 20/ However, the report also points out that the act "explicitly reserves common law copyright for one important class of works: works that have not been 'fixed in any tangible medium of expression.'" 21/ The report gives asexamples choreography, not filmed or notated; communications through conversations or live broadcasts; and improvised performances. 22/ Thus, as we shall see, the author in the highly creative butpre-publication stages may fall into a limbo between works which are tangibly fixed enough to put them within the scope of federal copyright subject matter, yet are either too minimal or not yet original enough to merit federal copyright protection under the Copyright Act of 1976.

The other part of 301 (b) which should be noted is 301 (b) (3). Here, "activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright . . . " are not preempted by the federal statute. 23/ The House of Representatives Report stated that 301 (b) (3) excludes some actions for privacy; publicity; trade secrets; defamation; fraud; contract; unfair competition; and some types of misappropriation, such as misappropriation of facts but not expression; from federal preemption. 24/ The report specifically states, however, that the tort of "interference with contractual relations" is merely the equivalent of copyright and thus would be preempted by the federal statute. 25/

The Senate version of the bill even enumerated common law and equitable actions such as certain types of misappropriation, breaches of contract, breaches of trust and so forth within section 301. However, in conference the House of Representatives

amendment, which did not enumerate such actions, was adopted. 26/

IV. State Statutory, Common Law, and Equitable Pre-Publication Rights of Authors

The changes brought about by the Copyright Act of 1976 have unsettled the familiar pre-publication rights of authors. Even the term publication has now been stripped of much, if not all, of its legal utility except for its importance in the notice requirement. The term is retained in this article simply as a shorthand phrase to describe the part of the creative process which precedes the point at which an author is ready to widely distribute her or his work to the general public in a polished completed form. It describes that stage where the author's ideas and partially formulated expression are worked on prior to the final expression -- much as a cook would work on various bases, sauces, doughs and batters before they are combined into the culinary expression of a fine meal.

In this section the surviving state statutory, common law, and equitable rights of authors will be examined. In the next section, protections found in the Copyright Act of 1976 itself will be examined.

Three broad categories of actions will be described in this section -- misappropriation and related actions; implied in fact contracts; and invasion of privacy. This is not meant to be an exhaustive list of areas where state statutory, common law and equitable rights might affect the prepublication rights of authors but it represents the most active area of appellate activity.

Misappropriation and Related Actions

The tort of misappropriation is one of the actions generally seen as part of the

broad general area of unfair competition. 27/ Misappropriation is the tort of copying or imitating ideas, designs, reports or products. 28/ The Supreme Court decided an early, yet still influential, case on misappropriation. In International News Service v. Associated Press, the Court found that a news agency could be enjoined from using the uncopyrighted news reports from another agency on a theory of misappropriation. 29/The Court's reasoning that the information constituted "hot" news and had commercial value is still echoed in the misappropriation cases. 30/

However, when the modern cases are analyzed, it appears that under the preemption clause of the Copyright Act of 1976, misappropriation actions are left with a very small role to play and usually fail. 31/ The courts usually find that the elements of misappropriation are similar to copyright and thus are both within the Act's subject matter and equivalent to copyright. Ironically, many of the modern cases still suggest that there is a possibility of presenting a misappropriation claim which would not be preempted, but the only examples they give are the "hot news" appropriation of facts outlined in International News Service and a limited extension of the concept to data updates from scientific, business, or financial data bases. 32/

Since misappropriation actions are rarely successful, authors in prepublication stages are often without remedy. Usually, authors attempt to use misappropriation actions because their copyright actions are untenable. 33/ Ironically, several state misappropriation actions require that the subject matter of the action be novel, unique or original. 34/ The closer an author gets to that standard the closer the author gets to preemption because the more likely that the ideas are reduced to some sort of fixed

medium of expression and thus enter the territory of federal copyright.

Contract Actions

An alternative to the often preempted misappropriation cause of action is an action based on breach of a quasi contract or a contract implied-in-fact. These actions are based on the theory that ideas which are disclosed in the course of confidential dealings create a contractual relationship.

The House Report was careful to distinguish between two types of contractual relationships. It suggested that the unfair competition concept of "interference with contractual relations" would be preempted because it is the equivalent of copyright protection but that other types of contract actions would not necessarily be preempted. 35/

The implied in fact contract is especially useful to the author in the prepublication stage because it protects the authors ideas before they are reduced to publishable form. As mentioned at the beginning of this article, authors often need to disclose their ideas long before the product is complete. The reasons for disclosure vary widely. For example, it is obvious that television writers must show their scripts to television producers 36/ and that film screen writers must share their work with film producers. 37/ Sales training consultants must disclose their ideas for new sales campaigns to companies who will pay for their services. 38/

There are also some exposures which are not obvious but still endanger the ideas of the author before publication. For example, an author of a book about a particular game might have to ask permission to use the game manufacturer's trademark. 39/ One

company, in a spirit of good will, might even provide file materials to a book author if she or he promises not to use the material to attack the company. 40/ In all of these situations, ideas are exposed.

California is the state which has been most vigorous in using the implied in fact contract to protect the ideas of authors before they are ready to publish their works. 41/ Other states use a very liberal concept of consideration to find contractual relationships between the parties sharing ideas. 42/

There are some limitations with this cause of action. Firstly, there must be a specific relationship between individual parties. Thus, an author who "floats" ideas through friend or third parties risks loss of those ideas because a specific relationship does not exist from which to imply a contract or its almost identical relative -- the breach of confidence action. 43/ Secondly, in some states there has to be a certain level of concreteness to the ideas -- something which might be difficult in the early stages of authorship. 44/

Invasion of Privacy

A final area where some state common law and statutory protection survives for authors is invasion of privacy. Privacy is not really one action, but rather an entire group of actions. The concept of privacy was first explicitly discussed by Boston businessman, and former attorney, Samuel Warren and his former law partner Louis Brandeis. 45/ More recently, the late Dean William Prosser said that privacy actions fall into four general categories:

1. Intrusion upon the plaintiff's seclusion or solitude, or into his private affairs.

2. Public disclosure of embarrassing private facts about the plaintiff.

3. Publicity which places the plaintiff in a false light in the public eye.

4. Appropriation, for the defendant's advantage, of the plaintiff's name or likeness. 46/

There are really two broad types of interests in Prosser's taxonomy. The first group of three interests can generally be said to involve the right to be left alone. The last one, although it can also be used to assert a right to be left alone, more often involves the protection of a commercial interest. Both types of protections might be potentially important toan author before publication. The first group of interests protects the author's, and perhaps society's, interest in turning out a polished intellectual product and theauthor's interest in being able to time the release of thework for maximum impact or the decision not to release thework at all. 47/ The second group affects the largely commercial interest of publicity. Here authors' want some control over the use of their names or even their performances. 48/ Of course, when dealing with the privacy ofinformation, First Amendment issues as well as general common law preference for a free flow of ideas weighs against privacy rights. 49/

Privacy actions are not a panacea for authors before publication. Firstly, not all states recognize privacy as a cause of action. 50/ Secondly, privacy rights may be preempted by the Copyright Act of 1976 -- both the personal privacy rights 51/ and the publicity rights of the last group. 52/ However, privacy rights do provide some limited additional common law and equitable remedies for authors of works prior to publication.

V. The Copyright Act and the First Amendment

At first blush, the Copyright Act of 1976 seems to extend significant copyright protection to authors who have not yet distributed their works to the public because their works are protected as soon as they are "fixed in a tangible medium of expression." 53/ However, as we have seen, there is vulnerability for authors whose ideas and notes have not yet been reduced to expression which rises to the level of "original works of authorship" for the purposes of the copyright act. 54/

The author, prior to publication, must be careful not to fall into the crevasse between state and federal protection. If the author's work is sufficiently advanced to be expression fixed in a tangible medium, then there is likely to be federal preemption of state statutory, common law, and equitable claims. If, on the other hand, the author's work is fixed but not yet advanced enough to embody originality, then federal copyright protection might be lost as well. "As long as the work fits within one of the general subject matter categories of sections 102 and 103, the Act prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify . . . ." 55/

The pre-publication author must also face one more hurdle in securing protection -- the fair use doctrine. 56/ As we have already seen in the state statutory, common law and equity section, there are usually two broad areas of competing interests which dominate copyright and intellectual property. Firstly, there is an interest in protecting the personal and economic interests of the author in the hope that such protection will lead to intellectual industry. Secondly, there is an interest in maintaining reasonable

public access to the fruits of intellectual industry. The fair use doctrine represents a codification of the aspirations to reasonable public access. 57/

There is a danger that the pre-publication efforts of an author might be "scooped" by another author who claims fair use. Such a case came before the United States Supreme Court in Harper & Row v. Nation Enterprises. 58/ It is well worth examining in some detail.

In the Nation case, the copyright owners of former President Gerald Ford's memoirs sold the rights to print prepublication excerpts to Time Magazine. The Nation Magazine acquired a copy of the manuscript and rushed into print with an article with numerous quotations from the book. 59/

Justice O'Connor, in writing the opinion of the Court, first recognized the unsettled nature of the law concerning the way that uncopyrightable elements combine with the author's original contributions to form protected expression and suggested, in dicta, that the "controversy between the lower courts in this case over copyrightability is more aptly styled a dispute over whether The Nation's appropriation of unoriginal and uncopyrightable elements encroached on the originality embodied in the work as a whole." 60/ However, since The Nation admitted to "lifting verbatim quotes of the author's original language . . . [and] effectively arrogated to itself the right to first publication . . . , " 61/ Justice O'Connor claimed that the Court did not need to reach those issues.

Next, Justice O'Connor examined fair use of unpublished material. After an examination of the 1976 act, she concluded that, "From the beginning, those entrusted

with the task of revision recognized the 'overbalancing reasons to preserve the common law protection of undisseminated works until the author or his successor chooses to disclose them.'" 62/ She then used a balancing test to weigh the interests in first publication against the interests in fair use. She ruled, "Under ordinary circumstances, the author's right to control the first public appearance of his undisseminated expression will outweigh a claim of fair use." 63/

Justice O'Connor then responded to the defendant's argument that the First Amendment justification for fair use is wider when dealing with matters of public importance. 64/ Justice O'Connor dismissed the argument by first examining the Constitutional justification for copyright. 65/ She found, "that the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas." 66/ Secondly, she found that even the First Amendment had a countervailing right not to speak. "Moreover, freedom of thought and expression 'includes both the right to speak freely and the right to refrain from speaking at all . . . .' Courts and commentators have recognized that copyright, and the right of first publication in particular, serve this countervailing First Amendment value." 67/

Justice Brennan, joined by Justices White and Marshall, wrote the dissenting opinion in Harper & Row v. Nation Enterprises. 68/ Justice Brennan argued that the majority had been over zealous in protecting authors economic interests at the expense of the public's interest in information. He wrote: "The Court has perhaps advanced the ability of the historian -- or at least the public official who has recently left office -- to

capture the full economic value of information in his or her possession. But the Court does so only by risking the robust debate of public issues that is the 'essence of self-government'" 69/

The key to Justice Brennan's analysis was his view of the "originality" requirement in sec. 102 of the Copyright Act of 1976. He saw "originality" as "crucial to the maintenance of the appropriate balance between these competing interests." 70/ To Justice Brennan, the greater the literary form incorporated in the work, the more the work is entitled to copyright protection. He wrote: "It follows that infringement of copyright must be based on a taking of literary form, as opposed to the ideas or information contained in a copyrighted work." 71/

The Nation case leaves open several important questions about the rights of authors prior to publication which will have to wait for future appellate cases. 72/ The most important question is what happens to materials at the early stages of research which may not be copyrightable in and of themselves. The manuscript in Nation was all but a finished product. But what would have been the outcome if The Nation had appropriated the material at a fairly early stage of authorship? 73/ Would the defense of the author's prepublication rights be as robust?

VI. Conclusions

Authors have three interests at stake during the very creative time before their works are published. Firstly, they seek to protect the labor which they invest in their works. Secondly, they want to hone their works until they feel that they are ready for publication. Lastly, they have an interest in timing the publication of their works so that

they will have maximum effect.

In addition to the interests of authors, the public has an interest in having access to the maximum amount of intellectual products -- what Justice Brennan calls "providing the grist for . . . robust debate." 74/ Speakers and authors relying on the First Amendment seek to express timely and undistorted information about the original author's work.

The problem is how to best deliver these two seemingly competing goals. One position, championed by the majority in Nation, is that intellectual productivity can be maximized by providing strong exclusive rights to authors to market and profit from their expression, if not the ideas intertwined with expression. The other position, championed by the minority in Nation, is that authors should have exclusive rights to only the most original aspects of intellectual industry.

The stage before publication has traditionally merited special attention. The old common law and equitable remedies inspired the new Act. After Nation, it appears that a work which meets the criteria for copyright is protected by a thumb on the scale in favor of unpublished, yet copyrightable, works and against fair use. 75/

On the other hand, works or ideas which do not meet the criteria are left to the surviving state statutory, common law, and equitable remedies. In this article, the health of three of those actions -- misappropriation, implied in fact contracts, and invasion of privacy -- was examined in the aftermath of implementation of the Copyright Act of 1976.

Misappropriation actions are the least successful. Only rarely do the actions

escape preemption under the 1976 Act. Privacy actions offer some help, but are also often preempted. Finally, in a few states, implied in fact contract actions are fairly successful and rarely fall to federal preemption. However, they are generally difficult to prove and, of course, work only if there is direct contact between the parties.

The system of protection for authors prior to publication under the Copyright Act of 1976 is probably not as strong as authors might like. Although authors can theoretically enjoy copyright as soon as their work is reduced to a tangible means of expression, much of the authorship work either has not been reduced to a tangible means of expression or it does not rise to the level of originality required under the Act. If the work of the author does not qualify for federal copyright protection, then all that is left are the surviving common law, equitable, and statutory remedies. Yet even these often fall to the harsh preemption clause of the 1976 Act. Ironically, the very time at which authors are the most creative is the time when they are most vulnerable under the Copyright Act of 1976.

While at first blush, this whole controversy may seem dry and highly technical -- best left to the publishing houses and lawyers specializing in copyright. However, the controversy goes to the heart of the question of how to best foster robust debate in a democratic society. Is it best to encourage debate by providing authors limited monopoly powers over their own expression and thereby create an economic engine to drive expression or is it better to give free access to the expression as well as the facts underlying the expression?

NOTES

1/ 17 U.S.C.A. sec. 101.

2/ Former 17 U.S.C.A. sec. 1 (repealed).

3/ 471 U.S. 539 (1985).

4/ U.S. Cost. art. I sec. 8.

5/ See, e.g., Harper and Row v. Nation Enterprises, 471 U.S. 539 (1985); Goldstein v. California, 412 U.S. 546(1973).

6/ See Sony Corporation of America v. Universal City Studios, 467 U.S. 417 (1984); Comment, A Regulatory Theory of Copyright: Avoiding a First Amendment Conflict, 35 Emory L.J. 163 (1986) (Stephen Zimmerman) ("The regulatory nature of copyright consists of a basic right to control reproduction of the work and the basic duty not to inhibit the 'public's need for unrestrained access to information.' Copyright as property and copyright as regulation are two distinct, yet interrelated concepts.")

7/ See, e.g., International News Service v. Associated Press, 248 U.S. 215 (1918) (The Court specifically approved a common law remedy as a means to protect the investment of skill, labor and money which the authors put into their news releases.); But see, W. Keeton, Prosser and Keeton on The Law of Torts, at 1021 (5th ed. 1984) (There has been a long common law commitment to competition and free use of ideas even in such actions as misappropriation).

8/ But see, e.g., National Business Lists v. Dun & Bradstreet, 552 F. Supp. 89 (N.D. Ill. 1982) (The court upheld copyright infringement for using directory information to make computerized mailing lists. The Court reviewed the directory cases

and found that the common law action of misappropriation was, in effect, incorporated in federal copyright protections. It noted that as works become more fact based and less literary in nature that a diligent application standard becomes more appropriate.)

9/ Former 17 U.S.C.A. sec. 10 (repealed) ("Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by the authority of the copyright proprietor . . . .")

10/ Former 17 U.S.C.A. sec. 2 (repealed) ("Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent and to obtain damages therefor.")

11/ H.R. No. 94-1476, 94th Cong. 2d Sess. (1976) reprinted in 17 U.S.C.A. sec. 301.

12/ Id.

13/ 18 Am.Jur.2d Copyright and Literary Property sec. 7 14/ 17 U.S.C.A. sec. 12 (repealed) ("The Copyright Act of1909 allowed some items which were not reproduced for sale to be copyrighted such as lectures, dramatic, musical, and dramatico-musical compositions.")

15/ 17 U.S.C.A. sec. 101.

16/ 17 U.S.C.A. sec. 102 (a) ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression,

now known or later developed, from which they can be perceived, reproduced, or otherwise communicated either directly or with the aid of a machine or device.")

17/ 17 U.S.C.A. sec. 102 (b) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such a work.")

18/ 17 U.S.C.A. sec. 301 (a) ("On or after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of a copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under common law or statutes of any State.")

19/ 17 U.S.C.A. sec. 301 (b).

20/ H.R. No. 94-1476, 94th Cong. 2d Sess. (1976), reprinted in U.S.C.A. sec. 301.

21/ Id.

22/ Id.

23/ 17 U.S.C.A. sec. 301 (b) (3).

24/ H.R. No. 94-1476 94th Cong. 2d Sess. (1976), reprinted in 17 U.S.C.A. sec. 301.

25/ Id.

26/ H.R. No. 94-1733 94th Cong. 2d Sess. (1976), reprinted in 17 U.S.C.A. sec. 301; 122 Cong. Rec. H-10910 (daily ed. Sept. 22, 1976) (When the bill came up for debate on the House floor, Representative Seiberling introduced an amendment to strike the enumeration of state statutory, common law and equitable actions. From the debate it appears that he had two purposes. First, he did not want to limit possible state statutory, common law and equitable remedies by describing only a few in the actual bill. Secondly, he felt that by listing misappropriation it would encourage states to pass laws so broad that they would render the preemption section meaningless).

27/ See, e.g., Financial Information v. Moody's Investors Service, 808 F.2d 204, 208 (2nd Cir. 1986); Schuchart & Associates v. Solo Serve Corporation, 540 F. Supp. 928, 943 (W.D. Tex. 1982).

28/ W. Keeton, Supra note 7, at 1020, 1015. ("Unfair competition torts are somewhat different than most torts because they "appear to involve less a question of tortious activity than a question of property to be protected. Intangible interests, such as those involved in patents, copyrights, trade marks, and trade secrets, are often treated as property and given protection even from innocent and unknowing infringement by others.")

29/ 248 U.S. 215 (1918).

30/ See, e.g. Financial Information v. Moody's Investors Service, 808 F.2d 204 (2nd Cir. 1986); Ehat v. Tanner, 780 F.2d 876 (10th Cir. 1986); Schuchart & Associates v. Solo Serve, 540 F. Supp. 928 (W.D. Tex. 1982).

31/ See, e.g. Del Madera Properties v. Rhodes and Gardner, 820 F.2d 820 (9th Cir. 1987) (action concerning the use of real estate plot maps preempted); Hartman v. Hallmark Cards, 833 F.2d 117 (8th Cir. 1987) (action concerning the misappropriation by Hallmark in using "Rainbow Bright" characters preempted); Financial Information v. Moody's Investor's Service, 808 F.2d 204 (2nd Cir. 1986) (action for use of daily bond cards was preempted); Ehat v. Tanner, 780 F.2d 876 (10th Cir. 1985) (action over graduate student's stolen research notes later copied and sold to the public was preempted); Schuchart & Associates v. Solo Serve Corp., 540 F. Supp. 928 (W.D. Tex. 1982) (action over the use of architectual plans by shopping center builders preempted); But see, e.g., Bromhall v. Rorvik, 478 F. Supp. 361 (E.D. Pa. 1979) (claim that defendant had used ideas from a thesis to write a book about the cloning of humans was not preempted).

32/ See, e.g., Financial Information v. Moody's Investor's Service, 808 F.2d 204, 208 (2nd Cir. 1986); Schuchart & Associates v. Solo Serve Corp., 540 F. Supp. 928, 943 (W.D. Tex. 1982).

33/ See, e.g., Financial Information v. Moody's Investor's Service, 808 F.2d 204 (2nd Cir. 1986) (daily bond cards were not sufficiently original to merit copyright protection).

34/ See, e.g., Sellers v. American Broadcasting Co., 668 F.2d 1207 (11th Cir. 1982) (exclusive story told to reporter Geraldo Rivera concerning the death of singer Elvis Presley was neither novel, unique, or original); Murray v. National Broadcasting Company, 671 F. Supp. 236 (S.D. N.Y. 1987) (employee's idea for television show

similar to NBC's Cosby Show was not sufficiently novel to be protected from misappropriation under N.Y. law); McGhan v. Ebersol, 608 F. Supp. 227 (S.D. N.Y. 1985) (idea for music video television show similar to NBC's Friday Night Videos was not novel enough to recover for misappropriation under N.Y. law). 35/ H.R. No. 94-1476, 94th Cong. 2d Sess. (1976) ("Nothing in the bill derogates from the rights of parties to contract with each other and to sue for breaches of contract; however, to the extent that the unfair competition concept known as 'interference with contract relations' is merely the equivalent of copyright protection, it would be preempted.").

36/ See, e.g., Whitfield v. Lear, 751 F.2d 90 (2nd Cir. 1984) (writer submitted script for television situation comedy to production company as was practice in the industry); Rokos v. Peck, 227 Cal. Rptr. 480 (Cal. App. 2 Dist. 1986) (teenage writer submitted her scripts about teenage suicide to an agent who showed them to television networks).

37/ See, e.g., Klekas v. EMI Films, 198 Cal. Rptr. 296 (Cal. App. 2 Dist. 1984) (amateur writer sent a copy of a story which allegedly became the basis for the film The Deerhunter); Mann v. Columbia Pictures, 180 Cal. Rptr. 522 (Cal. App. 2 Dist. 1982) (writer sent script to movie studio which allegedly became the basis for the film Shampoo).

38/ See Bergman v. Electrolux, 558 F. Supp. 1351 (D. Nev. 1983) (sales consultant submitted ideas which allegedly became part of a successful vacuum cleaner sales campaign).

39/ See Landsberg v. Scrabble Crossword Game Players, Inc., 802 F.2d 1193

(9th Cir. 1986) (writer of a game strategy book claims company took idea when he approached them to receive permission to use trademark).

40/ See Charles Atlas v. Time-Life Books, 570 F. Supp. 150 (S.D. N.Y. 1983) (company gave author an old advertisement from files and claims that author broke promise to refrain from disparagement of product).

41/ See, e.g., Landsberg v. Scrabble Crossword Game Players, Inc., 802 F.2d 1193 (9th Cir. 1986) ("California law allows for recovery for the breach of an implied in fact contract when the recipient of a valuable idea accepts the information knowing that compensation is expected, and subsequently uses the idea without paying for it. . . . If disclosure occurs before it is known that compensation is a condition of its use, however, no contract will be implied.").

42/ See, e.g., Charles Atlas v. Time-Life Books, 570 F. Supp. 150 (S.D. N.Y. 1983) (One party's promise to search files and the other party's promise not to represent the an exercise program in a derogatory manner was all the consideration needed under New York law.); But see, e.g. Bergman v. Electrolux, 558 F. Supp. 1351 (D. Nev. 1983) (Nevada law requires that a contractual relationship exist before the abstract idea is disclosed).

43/ See Rokos v. Peck, 227 Cal. Rptr. 480 (Cal. App. 2 Dist. 1986) ("A cause of action for breach of an implied-in- fact contract bears upon the relationship between the individual parties and makes breaches of such agreements actionable between parties because of the nature of their personal relationship." In California there is no practical difference between implied in fact contract actions and breach of confidence actions);

See also Klekas v. EMI Films, 198 Cal. Rptr. 296 (Cal. App. 2 Dist. 1984) (No contract existed between parties); Mann v. Columbia Pictures, 180 Cal. Rptr. 522 (Cal. App. 2 Dist. 1982) (no contract existed).

44/ See, e.g., Bergman v. Electrolux, 558 F. Supp. 1351 (D. Nev. 1983) (Abstract ideas are not protected unless there is novelty and concreteness. The novelty pertains to originality, innovation, and concreteness).

45/ Warren and Brandeis, The Right to Privacy, 4 Harv. L. Rev. 193 (1890).

46/ Prosser, Privacy, 48 Calif. L. Rev. 383, 389 (1960).

47/ See, e.g. Bromhall v. Rorvick, 478 F. Supp. 361 (E.D. Pa. 1979) (Privacy action appropriate for unreasonable invasion of private life but not for false light because the writing was largely true).

48/ See, e.g., Zacchini v. Scripps-Howard Broadcasting, 433 U.S. 562 (1977) (Human cannon ball may have had a right of publicity privacy action when a local television news crew filmed and aired his entire fifteen second act).

49/ Id. (The First Amendment did not necessarily nullify publicity actions); But see, e.g. Avins v. Moll, 610 F. Supp. 308 (E.D. Pa. 1984) (No invasion of privacy when a former law school dean's letters had little to do with private life and were of great importance to the dean's former school).

50/ See, e.g., Falwell v. Penthouse International, 521 F. Supp. 1204 (W.D. Va. 1981) (There is no right of privacy recognized in Virginia).

51/ See, e.g., Bromhall v. Rorvik, 478 F. Supp. 361 (E.D. Pa. 1979) (Privacy actions are not preempted by the Copyright Act of 1976 because they refer to ideas and

not the expression of the ideas).

52/ See Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (Publicity action appropriate before the Copyright Act of 1976 when television stationed aired the entire act of a human cannonball); But see, e.g. Baltimore Orioles v. Major League Baseball Players, 805 F.2d 663 (7th Cir. 1986) (Professional baseball players have no right of publicity in their performances when the games are being simultaneous videotaped in a fixed medium of expression and hence copyrighted by a cable company under contract with their team); But see also, Rowe v. Golden West TV, 445 A.2d 1165 (N.J. Super. A.D. 1982) (Inmates at Prison who participated in "Scared Straight" television documentary did not have common law copyrights in their performances because of preemption by the Copyright Act of 1976).

53/ 17 U.S.C.A. sec. 102.

54/ Id.

55/ H.R. No. 94-1476, reprinted in 17 U.S.C.A. sec. 301.

56/ 17 U.S.C.A. sec. 107 ("Notwithstanding the provisions of 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.").

57/ H.R. No. 94-1476, 94th Cong. 2d Sess. (1976).

58/ 471 U.S. 539 (1985).

59/ 471 U.S. at 542-545.

60/ 471 U.S. at 548.

61/ 471 U.S. at 548-549.

62/ 471 U.S. at 553.

63/ 471 U.S. at 555.

64/ U.S. Const. amend. I.

65/ U.S. Const. art. I, sec. 8.

66/ 471 U.S. at 558.

67/ 471 U.S. at 559.

68/ 471 U.S. at 579.

69/ 471 U.S. at 605.

70/ 471 U.S. at 580.

71/ 471 U.S. at 582.

72/ Compare Salinger v. Random House, 811 F.2d 90 (2nd Cir. 1987) (an author who used without permission private letters of author J. D. Salinger, which had been donated to a library, did not engage in fair use) with Fryharger v. International Business Machines, 812 F.2d 525 (9th Cir. 1987) (similar ideas in two video games were non-protectable ideas not entitled to federal copyright protection).

73/ 471 U.S. at 546 (In discussing the facts, the Court describes President Ford's authorship process. It is interesting to look at the authorship process which the President went through in order to produce the book in its final form. "The book at issue here was two years in the making and began with a contract giving the author's copyright to the publishers in exchange for their services in producing and marketing the work. Mr.

Ford drafted essays and word portraits of public figures and participated in hundreds of taped interviews that were later distilled to chronicle his personal viewpoint.")

74/ Harper & Row v. Nation Enterprises, 471 U.S. 539, 605 (1985) (Brennan, J. dissenting).

75/ Id. at 533 (majority opinion).

76/ Id at 552.

BIBLIOGRAPHY

Cases

Avins v. Molls, 610 F. Supp. 308 (E.D. Pa. 1984)

Baltimore Orioles v. Major League Baseball Players, 805 F.2d 663 (7th Cir. 1986).

Bergman v. Electrolux Corp., 558 F. Supp. 1351 (D. Nev. 1983).

Bromhall v. Rorvik, 478 F. Supp. 361 (E.D. Pa. 1979).

Charles, Atlas, Ltd. v. Time Life Books, Inc., 570 F. Supp. 150 (S.D. N.Y. 1983).

Del Madera Properties v. Rhodes and Gardner, Inc., 820 F.2d 973 (9th Cir. 1987).

Ehat v. Tanner, 780 F.2d 876 (10th Cir. 1985).

Fallwell v. Penthouse International, Ltd., 521 F. Supp. 1204 (W.D. Va. 1981).

Financial Information v. Moody's Investor's Services, 808 F.2d 204 (2nd Cir. 1986).

Fryharger v. International Business Machines, 812 F.2d 525 (9th Cir. 1987).

Harper & Row v. Nation Enterprises, 471 U.S. 539, 85 L.Ed.2d 588, 105 S.Ct. 2218 (1985).

Hartman v. Hallmark Cards, 833 F.2d 117 (8th Cir. 1987).

Hays v. Sony Corp. of America, 833 F.2d 412 (7th Cir. 1988).

Klegas v. EMI Films, Inc., 198 Cal. Rptr. 296 (Cal. App. 2 Dist. (1984).

Landsberg v. Scrabble Crossword Game Players, Inc., 802 F.2d 1193 (9th Cir. 1986).

Mann v. Columbia Pictures, Inc., 180 Cal. Rptr. 522 (Cal. App. 2 Dist. 1982).

McGahn v. Ebersol, 608 F. Supp. 227 (S.D. N.Y. 1985).

Murray v. National Broadcasting Company, 671 F. Supp. 227 (S.D. N.Y. 1985).

Prince Albert v. Strange, 2 De G. & Sm. 652, 674 Eng. Rep. 293, 79 Rev. Rep. 307 (1849).

Rokos v. Peck, 227 Cal. Rptr. 480 (Cal. App. 2 Dist. 1986).

Rowe v. Golden West T.V., 445 A.2d 1165 (N.J. Super. A.D. 1982).

Salinger v. Random House, Inc., 811 F.2d 90 (2nd Cir. 1987).

Shuchcart & Associates v. Solo Serve Corp., 540 F. Supp. 928 (W.D. Tex. 1982).

Sellers v. American Broadcasting Co., 688 F.2d 1207 (11th Cir. 1982).

Whitfield v. Lear, 751 F.2d 90 (2nd Cir. 1984).

Legislative Materials

17 U.S.C. sec. 101.

Former 17 U.S.C. sec. 1 (repealed).

H.R. No. 94-1476.

H.R. No. 94-1733.

Books

M. Nimmer & P. Geller, International Copyright Law and Practice (1988).

Periodicals

Coyne, Toward a Modified Fair Use Defense in Right of Publicity Cases, 29 Wm. &

Mary L. Rev. 781 (1988).

Fisher, Reconstructing the Fair Use Doctrine, 101 Harv. L. Rev. 1659 (1988).

Francione, Facing the Nation: The Standards for Copyright, Infringement, and Fair Use of Factual Works, 134 U. Pa. L. Rev. 519 (1986).

Personal Letters: A Dilemma for Copyright and Privacy Law, 33 Rutgers L. Rev. 134 (1980) (authored by Alan Lee Zegas).

Prosser, Privacy, 48 Calif. L. Rev. 383 (1960).

Comment, A Regulatory Theory of Copyright: Avoiding a First Amendment Conflict, 35 Emory L.J. 163 (1986) (authored by Stephen S. Zimmermann.

Schiffres, Copyright and Literary Property, 18 Am Jur 2d 323 (1988).

Note, Taking of Verbatim Quotations in Maxtone-Graham v. Burtchaell: An Unfair Use, 49 U. Pitt. L. Rev. 617 (1988) (Authored by Elaine B. Krasik).

Warren & Brandeis, The Right to Privacy, 4 Harv. L. Rev. 193 (1890).